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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/719,589

12/14/2000

Ahti Muhonen

PM275251/298

3424

909 7590 02/20/2004

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EXAMINER

MOORE JR, MICHAEL J

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 02/20/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/719,589

Applicant(s)

MUHONEN ET AL.

Examiner

Michael J Moore, Jr.

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1,2,8-10,14-16,18,19,21 and 23 is/are rejected.
- 7) ☒ Claim(s) 3-7,11-13,17 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1, 2, 10, and 16** are rejected under 35 U.S.C. 102(e) as being anticipated by Fortman et al. (U.S. 5,987,100). The Fortman et al. reference discloses all of the limitations of the listed claims for the reasoning that follows.

Regarding claim **1**, the claimed limitation is a method for delivering messages between a terminal and a second party in a wireless telecommunications network. This method transmits messages through a universal message service center irrespective of the content type of the messages. This method also transmits messages between the terminal and the message service center using the same protocol. Column 1, lines 4-30 along with Figures 1 and 2 of the Fortman et al. reference anticipate this limitation. In Figure 2, Fortman et al. discloses a universal mailbox 230 (message service centre) that notifies subscribers such as Internet terminal 216 (terminal) and wireless terminal 218 (second party) of any type of message that is waiting for them such as voice mail, fax mail, e-mail, etc. The IP protocol (same protocol) is used to transmit messages between the Internet terminal 216 (terminal) and universal mailbox 230 (message

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service centre). This universal mailbox 230 performs protocol conversions between the format employed by the universal mailbox 230 and the various formats used by the different subscriber equipment.

Regarding claim 2, the method of claim 1 where the message content includes at least two different content types (text, speech, images, video images, or combinations of these) is anticipated by column 1, lines 16-21 as well as Figures 1 and 2 of the Fortman et al. reference. Figure 1 shows messaging services such as voice and fax messaging, e-mail, wide area paging, video messaging, and interactive voice response that are provided in host messaging center 140. Figure 2 shows different subscriber equipments that deliver messages of different content types through a universal mailbox 230 (message service centre).

Regarding claim 10, the claimed limitation is a system that comprises at least one terminal that is capable of receiving messages of at least two different content types. This system also contains a message service center used for delivering these messages to a terminal using a first protocol. Column 1, lines 4-30 along with Figures 1 and 2 of the Fortman et al. reference anticipate this limitation. Column 1, lines 4-30 along with Figures 1 and 2 of the Fortman et al. reference anticipate this limitation. In Figure 2, Fortman et al. discloses a universal mailbox 230 (message service centre) that notifies subscribers such as Internet terminal 216 (terminal) and wireless terminal 218 (second party) of any type of message that is waiting for them such as voice mail, fax mail, e-mail, etc. The IP protocol (same protocol) is used to transmit messages between the Internet terminal 216 (terminal) and universal mailbox 230 (message

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service centre). This universal mailbox 230 performs protocol conversions between the format employed by the universal mailbox 230 and the various formats used by the different subscriber equipment.

Regarding claim **16**, the claimed limitation is a message service center that contains interface means for receiving and forwarding at least two different types of messages and an application means for delivering and receiving messages to/from a terminal using the same protocol. Column 4, lines 16-21 as well as Figure 3 of the Fortman et al. reference anticipate this limitation. Figure 3 shows a block diagram of the elements of universal mailbox 230 of Figure 2. This mailbox includes an interface 310 used to connect the universal mailbox 230 to different telecommunications networks such as the PTN and the Internet terminal 216. This mailbox also includes a service provider 320 that is used to provide subscriber services as shown in Figure 5. This service provider 320 constitutes an application means. The IP protocol (same protocol) is used to transmit messages between the Internet terminal 216 (terminal) and universal mailbox 230 (message service centre). Also, column 1, lines 22-30 states how protocol conversions are performed to create an interface between the universal mailbox and the respective terminal. These protocol conversions constitute using a same protocol 1 between universal mailbox 230 and Internet terminal 216 as well as a same protocol 2 between universal mailbox 230 and wireless terminal 218 and providing message exchange between them.

***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims **8 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortman et al. in view of Farris et al. (U.S. 6,574,216).

Regarding claim **8**, Fortman et al. discloses a method as claimed in claim **1**. Fortman et al. does not disclose delivering messages to a terminal using at least two different delivery routes based upon a second condition. However, Figure 3 as well as the abstract of Farris et al. teaches a method whereby the quality of service existing in a data packet network is monitored. A minimum acceptable level of service condition (predetermined condition) may be predefined in a user's call processing record. If the quality of service condition through the Internet route of Figure 3 between terminals 11 and 15 is not satisfactory, the call may be routed through the PSTN route instead. At

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the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to add this alternate routing feature of Farris et al. to the message delivery method of the Fortman et al. reference. A motivation for doing so would be to provide a wireless message delivery method with better quality of service standards as stated in the abstract of the Farris et al. reference.

Regarding claim 19, Fortman et al. discloses a message service center with an interface 310 used to connect the universal mailbox 230 (message service centre) to different telecommunications networks such as the PTN and the Internet terminal 216. This mailbox also includes a service provider 320 that is used to provide subscriber services as shown in Figure 5. This service provider constitutes an application means. Fortman does not disclose the method of selecting a delivery route for each message on the basis of one or more predetermined conditions. However, Figure 3 as well as the abstract of Farris et al. teaches a method whereby the quality of service existing in a data packet network is monitored. A minimum acceptable level of service condition (predetermined condition) may be predefined in a user's call processing record. If the quality of service condition through the Internet route of Figure 3 between terminals 11 and 15 is not satisfactory, the call may be routed through the PSTN route instead. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to add this alternate routing feature of Farris et al. to the message delivery method of the Fortman et al. reference. A motivation for doing so would be to provide a wireless message delivery method with better quality of service standards as stated in the abstract of the Farris et al. reference.

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6. Claims **9, 14, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortman et al. in view of Ardalan et al. (U.S. 6,396,839).

Regarding claim **9**, Fortman et al. discloses a method as claimed in claim **1**. Fortman et al. does not disclose the added feature of checking packet size and performing packet segmentation if necessary. However, Ardalan et al. teaches in column 3, lines 5-32 a method where a gateway checks packet size and segments the packet into smaller pieces if the packet is larger than the maximum allowable size. Each piece of the segmented packet is then transmitted individually. Once all segments have been transmitted successfully, the original packet is then recomposed. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to add this packet checking and segmentation feature of Ardalan et al. to the message delivery method of the Fortman et al. reference. A motivation for doing so would be to allow packets larger than the maximum allowable size to be transmitted as described in column 3, lines 5-32 of the Ardalan et al. reference.

Regarding claim **14**, Fortman et al. discloses a system as claimed in claim **10**. Fortman et al. does not disclose the added feature of packet size checking and optional packet segmentation performed by the message service center. However, Ardalan et al. teaches in column 3, lines 5-32 a method where a gateway checks packet size and segments the packet into smaller pieces if the packet is larger than the maximum allowable size. Each piece of the segmented packet is then transmitted individually. Once all segments have been transmitted successfully, the original packet is then recomposed. At the time of the invention, it would have been obvious to a person of



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ordinary skill in the art given these references to add this packet checking and segmentation feature of Ardalan et al. to the message delivery system of the Fortman et al. reference. A motivation for doing so would be to allow packets larger than the maximum allowable size to be transmitted as described in column 3, lines 5-32 of the Ardalan et al. reference.

Regarding claim 18, Fortman et al. discloses a message service center as claimed in claim 16. Fortman et al. does not disclose the added feature of packet size checking and optional packet segmentation performed by the application means part of the message center. However, Ardalan et al. teaches in column 3, lines 5-32 a method where a gateway checks packet size and segments the packet into smaller pieces if the packet is larger than the maximum allowable size. Each piece of the segmented packet is then transmitted individually. Once all segments have been transmitted successfully, the original packet is then recomposed. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to add this packet checking and segmentation feature of Ardalan et al. to the message service center of the Fortman et al. reference. A motivation for doing so would be to allow packets larger than the maximum allowable size to be transmitted as described in column 3, lines 5-32 of the Ardalan et al. reference.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fortman et al. in view of Ardalan et al. and in further view of Van Renesse et al. (U.S. 6,208,651). Fortman et al. discloses a system as claimed in claim 10. Ardalan et al. discloses a system as claimed in claim 14. Fortman et al. and Ardalan et al. both do not disclose

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the added limitation of the message service center having the capability of packing an unpacked message before the packet size check is carried out. However, Van Renesse et al. discloses a packer 20 in Figure 2 that is used to pack messages when a message backlog exists. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to add this message-packing feature of Van Renesse et al. to the message delivery system of the Fortman et al. reference. A motivation for doing so would be to significantly reduce the latency of individual messages as stated in column 9, lines 42-47 of the Van Renesse et al. reference.

8. Claims **21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Virtanen (U.S. 6,249,681) in view of Fortman et al. (U.S. 5,987,100).

Regarding claim **21**, the claimed limitation is a mobile station comprising a user interface that is used to receive messages of at least two different content types. This mobile station also includes a controller used for receiving at least two different types of messages using the same protocol. Virtanen discloses in column 6, lines 1-39 as well as in Figure 1 a mobile station 10 comprising a controller 18 coupled to a user interface consisting of a speaker 17, a microphone 19, a display 20, and a keypad 22. The controller and user interface are used to send and receive messages. Virtanen does not disclose the added limitations of different message content type and the use of the same protocol. However, Fortman et al. discloses on column 1, lines 12-21 as well as Figure 2 different messaging services such as voice and text messaging that are transmitted by protocol conversions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to combine the

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capability of receiving messages of different content type using a same protocol as shown in Fortman et al. with the mobile station described in the Virtanen et al. reference. A motivation for doing so would be to improve the message service capabilities of the mobile station as stated in column 1, paragraph 2 of the Fortman et al. reference.

Regarding claim **23**, the claimed limitation is a mobile station comprising a user interface that is used to send messages of at least two different content types. This mobile station also includes a controller used for sending at least two different types of messages using the same protocol. Virtanen discloses in column 6, lines 1-39 as well as in Figure 1 a mobile station 10 comprising a controller 18 coupled to a user interface consisting of a speaker 17, a microphone 19, a display 20, and a keypad 22. The controller and user interface are used to send and receive messages. Virtanen does not disclose the added limitations of different message content type and the use of the same protocol. However, Fortman et al. discloses on column 1, lines 12-21 as well as Figure 2 different messaging services such as voice and text messaging that are transmitted by protocol conversions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art given these references to combine the capability of sending messages of different content type using a same protocol as shown in Fortman et al. with the mobile station described in the Virtanen et al. reference. A motivation for doing so would be to improve the message service capabilities of the mobile station as stated in column 1, paragraph 2 of the Fortman et al. reference.

***Allowable Subject Matter***

9. Claim **20** is allowed.

10. The following is an examiner's statement of reasons for allowance:

Regarding claim **20**, the prior art teaches a message service centre connected to a wireless telecommunications system that contains an interface means for receiving messages of at least two different content types and for forwarding to a terminal. The prior art also teaches an application means for selecting the manner of delivery of messages by checking whether a message meets at least one predetermined condition. The prior art fails to teach either delivering the message directly to the terminal or informing the terminal about the message and delivering the message to the terminal as a response to a message request concerning the message by the application means in response to the result of the predetermined condition check.

11. Claims **3-7, 11-13, 17, and 22** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments filed January 30, 2004 have been fully considered but they are not persuasive. The submission of the abstract on a separate sheet of paper as required by 37 CFR 1.72(b) is proper and has been admitted. However, the claim rejections of claims **1, 2, 8-10, 14-16, 18, 19, 21, and 23** remain standing for the reasoning that follows.

It is argued that the prior art fails to teach anything regarding the use of a "same protocol for transferring messages irrespective of the content type of the message".

However, Fortman teaches a universal mailbox that transmits and receives messages of different content types (voice messaging, fax, e-mail, audio text, speech, etc.).

Fortman also shows in Figure 2, for example, a connection between the universal mailbox 230 and an Internet terminal 216. This connection uses a protocol to communicate between the terminal (Internet terminal 216) and the message service centre (universal mailbox 230), which is a "same protocol". Based upon what is claimed, Fortman et al. anticipates this limitation.

It is also argued that Fortman et al. fails to teach anything regarding the protocol used when the message is transferred between a user terminal and a message service centre. However, all that is claimed is the use of a "same protocol" between a message service centre and a terminal. Figure 2 shows a universal mailbox 230 that is connected to various terminals such as an Internet terminal 216, and some mobile wireless terminals 217, 218, and 219. In order for each of these terminals to communicate to the universal mailbox in their own right, a protocol must be used.

Therefore, Farris et al., Ardalan et al., Van Renesse et al., and Virtanen further anticipate the corresponding claims as described in the above art rejection sections. Also, there was some confusion as to the phrase "protocol conversions constitute using the same protocol", which has been clarified above.

### ***Conclusion***

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13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (703) 305-8703. The examiner can normally be reached during the hours of 8:30am - 5:00pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (703) 308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjm MM

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